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REMARKS

This Application has been carefully reviewed in light of the Office Action mailed February 2, 2004. Claims 1, 22, 28, and 34 have been amended to further clarify what Applicant's believe to be the invention. Claims 29 and 56 have been amended to correct minor informalities. Applicants submit that no new matter has been added through the claim amendments. As described below, Applicants believe all claims to be allowable over the cited reference. Therefore, Applicants respectfully request reconsideration and full allowance of all pending claims.

Allowable Subject Matter

Applicants note with appreciation the Examiner's indication that Claims 7-9, 25, 31, and 40-42 would be allowable if rewritten in independent form to include all the limitations of the base claim and any intervening claims. However, these claims depend from independent Claims 1, 22, 28, and 34, respectively, which are allowable for the reasons discussed below. Therefore, Applicants respectfully submit that Claims 7-9, 25, 31, and 40-42 are allowable in their current form.

Section 112 Rejections

The Examiner rejects Claims 29-30 and 56-57 under 35 U.S.C. § 112, second paragraph, as having insufficient antecedent bases. Applicants have amended Claims 29 and 56 to correct the informalities indicated by the Examiner. Therefore, Applicants respectfully request that these rejections be withdrawn.

Section 103 Rejections

The Examiner rejects Claims 1-3, 10-16, 18-24, 26-30, 32-36, 43-56, and 51-59 under 35 U.S.C. §103(a) as being unpatenable over U.S. Patent No. 6,266,343 issued to Caves ("Caves") in view of U.S. Patent No. 6,438,137 issued to Turner, et al. ("Turner"). Furthermore, the Examiner rejects Claims 4-6 and 37-39 under 35 U.S.C. §103(a) as being unpatenable over Caves in view of Turner and further in view of U.S. Patent No. 6,351,471 issued to Robinett, et al. ("Robinett").

In order to establish a *prima facie* case of obviousness, three requirements must be met: (1) there must be some suggestion or motivation, either in the references themselves or

in the knowledge available to one skilled in the art, to modify a reference or combine multiple references; (2) there must be a reasonable expectation of success; and (3) the prior art reference (or combination of references) must teach or suggest all of the claim limitations.[1] In the present case, a *prima facie* case of obviousness cannot be maintained for at least two reasons. First, neither *Caves*, *Turner*, nor *Robinett* provides a suggestion or motivation to combine the references. Second, even assuming for the sake of argument that the references did suggest or motivate a combination of the references to a person of ordinary skill in the art at the time of the invention, *Caves*, *Turner*, and *Robinett,* whether considered alone, in combination with one another, or in combination with information generally available to those of ordinary skill in the art at the time of the invention, still fail to disclose all of the elements of the pending claims.

A.   No Motivation or Suggestion to Combine *Caves, Turner,* and *Robinett*

The M.P.E.P. sets forth a strict legal standard for finding obviousness based on a combination of references. According to the M.P.E.P., "Obviousness can only be established by combining or modifying the teachings of the prior art to produce the claimed invention where there is some teaching, suggestion, or motivation to do so found either explicitly or implicitly in the references themselves or in the knowledge [that was] generally available to one of ordinary skill in the art" at the time of the invention.[2] The "fact that references can be combined or modified does not render the resultant combination [or modification] obvious unless the prior art also suggests the desirability of the combination" or modification.[3]

The governing Federal Circuit case law makes this strict legal standard even clearer.[4] According to the Federal Circuit, "a showing of a suggestion, teaching, or motivation to combine . . . prior art references is an essential component of an obviousness holding."[5] "Evidence of a suggestion, teaching, or motivation . . . may flow from the prior art references themselves, the knowledge of one of ordinary skill in the art, or, in some cases, the nature of

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[1] *See* M.P.E.P. § 2143.
[2] M.P.E.P. § 2143.01.
[3] *Id.* (emphasis in original).
[4] Note M.P.E.P. § 2145(X)(C) ("The Federal Circuit has produced a number of decisions overturning obviousness rejections due to a lack of suggestion in the prior art of the desirability of combining references.").
[5] *In re Sang-Su Lee*, 277 F.3d 1338, 1343 (Fed. Cir. 2002) (quoting *Brown & Williamson Tobacco Corp. v. Philip Morris Inc.*, 229 F.3d 1120, 1124-25 (Fed. Cir. 2000)).

the problem to be solved."[6] However, the "range of sources available . . . does not diminish the requirement for actual evidence."[7] In *In re Dembiczak*, the Federal Circuit reversed a finding of obviousness by the Board of Patent Appeals and Interferences, explaining that proper evidence of a teaching, suggestion, or motivation to combine is essential to avoid impermissible hindsight reconstruction of an applicant's invention:

> Our case law makes clear that the best defense against the subtle but powerful attraction of hindsight obviousness analysis is *rigorous application of the requirement for a showing of the teaching or motivation to combine prior art references.* Combining prior art references without evidence of such a suggestion, teaching, or motivation simply takes the inventor's disclosure as a blueprint for piecing together the prior art to defeat patentability—the essence of hindsight.[8]

In the present case, the Examiner is improperly using the Applicants' disclosure as a blueprint for piecing together various elements of *Caves*, *Turner*, and *Robinett*. In addition, the Examiner has merely stated that at the time the present invention was made, it would have been obvious for one of ordinary skill in the art to combine the teachings of *Caves*, *Turner*, and *Robinett*. However, even a determination that it would have been obvious to one of ordinary skill in the art at the time of the invention to try the proposed combination is not sufficient to establish obviousness.[9]

Furthermore, a prima facie case of obviousness may not be maintained for at least Claims 4-6 and 37-39 because *Robinett* teaches away from the claimed invention.[10] Claim 4 recites "inserting one or more silence placeholders to fill a time interval during which no incoming media packets are received from a particular telephony device." Claim 37 recites similar, although not identical, limitations. Claims 5-6 and 38-39, which depend on Claims 4 and 37, respectively, also recite the use of silence placeholders. Although *Robinett* discloses that empty packets are sometimes found in data streams, the reference actually teaches away from inserting "silence place holders" into data packets. *Robinett* specifically notes that "it is

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[6] *In re Dembiczak*, 175 F.3d 994, 999 (Fed. Cir. 1999).
[7] *Id.*
[8] 175 F.3d at 999 (quoting *W.L. Gore & Assoc., Inv. v. Garlock, Inc.*, 721 F.2d 1540, 1553 (Fed. Cir. 1983)) (emphasis added) (citations omitted); *see also In Re Jones*, 958 F.2d 347, 351 (Fed. Cir. 1992) ("Conspicuously missing from this record is any evidence, other than the PTO's speculation (if that can be called evidence) that one of ordinary skill in the herbicidal art would have been motivated to make the modification of the prior art salts necessary to arrive at" the claimed invention.).
[9] *See In re Fine*, 837 F.2d 1071, 1075 (Fed. Cir. 1988).
[10] *See* M.P.E.P. § 2144.05 (III).

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desirable to reduce the number of such bandwidth wasting null packets." (*Robinett*, Col. 39, Lines 62-64). In fact, *Robinett* is directed toward an invention that replaces null packets with data packets. (*Robinett*, Col. 39, Line 66 – Col. 40, Line 3). Consequently, a person of skill in the art would not be motivated to insert empty packets into the data streams disclosed in *Caves* or *Turner* because *Robinett* is directed toward a system and method for replacing null packets with data packets and teaches that inserting empty packets into data streams is undesirable (*Robinett*, Col. 39, Line 61 – Col. 40, Line 2).

Consequently, a *prima facie* case of obviousness cannot be maintained with respect to Claims 1-16, 18-49, and 51-59, as the Examiner has not shown the requisite proof necessary to establish a suggestion or motivation to combine the cited references. For at least this reason, Applicants respectfully request reconsideration and allowance of Claims 1-16, 18-49, and 51-59.

B.   *Caves, Turner*, and *Robinett* **Fail to Disclose, Teach or Suggest Each and Every Element of Claims 1-16, 18-49, and 51-59**

1.   **Claims 1, 22, 28, and 34 are Allowable Over the Cited References**

Independent Claim 1, as amended, of the present application recites the following:

> A method for enabling communication between a plurality of telephony devices, comprising:
> receiving incoming media packets from each telephony device;
> dividing an incoming payload section of each incoming media packet into one or more data segments;
> mixing the data segments from two or more of the telephony devices to create an aggregate data segment having a length equal to a length of each of the data segments mixed to create the aggregate data segment; and
> constructing an outgoing payload section for one or more of the telephony devices by linking successively generated aggregate data segments.

Amended independent Claims 22, 28, and 34 recite similar, although not identical, claim limitations.

Claim 1, as amended, recites "mixing the data segments from two or more of the telephony devices to create an aggregate data segment having a length equal to a length of each of the data segments mixed to create the aggregate data segment." Claims 22, 28, and 34, as amended, recite similar, although not identical, limitations. The Examiner states that the *Caves-Turner* combination discloses all of the limitations of Claims 1, 22, 28, and 34. (Office Action mailed 2/2/04, Pages 2-3, ¶2, citing *Caves*, Figures 1-2; Col. 2, Lines 41-49; Col. 3; Lines 3-49; Col. 4, Lines 13-31). However, *Caves* merely discloses that the payload of incoming data packets of one format may be segmented and concatenated, with the concatenated segments being loaded into the payload section of consecutive packets of a second format. (*Caves*, Col. 4, Lines 19-24). *Caves* also discloses that a packet of the second format only carries segments of the first format coming from a single source. (*Caves*, Col. 4, Lines 26-29). Thus, *Caves* fails to disclose *mixing* data segments, let alone mixing the data segments from two or more of the telephony devices to create an *aggregate data segment having a length equal to a length of each of the data segments mixed to create the aggregate data segment,* as recited in amended Claim 1, and similarly, although not identically, in amended Claims 22, 28, and 34. Furthermore, the Examiner does not indicate any portions of *Turner* or *Robinett* that disclose, teach, or suggest this limitation.

In addition, Claim 1, as amended, recites "constructing an outgoing payload section for one or more of the telephony devices by linking successively generated aggregate data segments." Claims 22, 28, and 34, as amended, recite similar, although not identical, limitations. *Cave* fails to disclose that the outgoing payload section is constructed by linking *successively generated aggregate data segments.* Assuming, for the sake of argument, that *Caves'* data segments are combined to form an "aggregate data segment," the aggregate data segment comprises the entire payload section of the packet. Therefore, the *Caves* payload is constructed of, at best, a single aggregate data segment, rather than being constructed by linking successively generated aggregate data segments, as recited in amended Claim 1, and similarly, although not identically, in amended Claims 22, 28, and 34. Furthermore, the Examiner does not indicate any portions of *Turner* or *Robinett* that disclose, teach, or suggest this limitation.

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For at least these reasons, amended Claims 1, 22, 28, and 34 are allowable over the cited references. Therefore, Applicants respectfully request reconsideration and allowance of amended Claims 1, 22, 28, and 34, as well as all claims that depend from these claims.

2. Claims 15, 48, and 55 are Allowable over the Cited References

Independent Claim 15 of the present application recites:

> A method for enabling payload size conversion, comprising:
> receiving incoming media packets from one or more devices;
> dividing a first payload section of a first incoming packet into one or more full segments of equal size and a remainder segment containing the remainder of the first payload section; and
> constructing an outgoing payload section for the one or more devices by linking a selected number of successive segments.

Claims 48 and 55 recite similar, although not identical, limitations.

Claim 15 recites "dividing a first payload section of a first incoming packet into one or more full segments of equal size and a remainder segment containing the remainder of the first payload section." Claims 48 and 55 recite similar, although not identical, limitations. The Examiner states that *Caves* discloses this limitation. (Office Action mailed 2/2/04, pages 3, ¶2 citing *Caves*, Figures 2,4 and Col. 4, Lines 13-31). However, *Caves* merely discloses that incoming packets of a first format are segmented *as required* to enable their formation into a packet of a second format. (*Caves*, Col. 4, Lines 16-19). Furthermore, while *Caves* discloses that a 48 octet packet payload of a first format may be divided into two equal size 24 octet payloads of a second format, no remainder segment is present. (*Caves*, Figure 5; Col. 4, Line 55 – Col. 5, Line 38). In fact, *Caves* notes that "any segment length that is a *whole number divisor* of 48 may be used," thereby clearly indicating that no remainder segment is created. (*Caves*, Col. 5, Lines 11-13, emphasis added). Therefore, *Caves* fails to disclose dividing a first payload section of a first incoming packet into one or more full segments of equal size and a *remainder segment containing the remainder of the first payload section*, as recited in amended Claims 15, 48, and 55. Furthermore, the Examiner does not indicate any portions of *Turner* or *Robinett* that disclose, teach, or suggest this limitation.

For at least this reason, amended Claims 15, 48, and 55 are allowable over the cited references. Therefore, Applicants respectfully request reconsideration and allowance of amended Claims 15, 48, and 55, as well as all claims that depend from these claims.

3. The Rejected Dependent Claims are Allowable over the Cited References

Dependent claims 2-6, 10-14, 16, 18-21, 23-24, 26-27, 29-30, 32-33, 35-39, 43-47, 49, 51-54, and 56-59 are allowable over the cited references because they incorporate all of the limitations contained in their respective independent base Claims 1, 15, 22, 28, 34, 48, and 55, which have been shown to be allowable for the reasons discussed above. In addition, several dependent claims are allowable because they contain additional limitations not disclosed in the cited references.

Claim 3 recites "constructing an outgoing payload section for a telephony device from which incoming media packets were not received by linking a selected number of successively generated aggregate data segments appropriate for the telephony device." Claim 36 recites similar, although not identical, limitations. The Examiner states that the *Caves-Turner* combination discloses this limitation. (Office Action mailed 2/2/04, pages 2-3, citing *Caves*, Figures 1-2; Col. 2, Lines 41-49; Col. 3, Lines 3-49; Col. 4, Lines 13-31). *Caves* merely discloses that the payload of a second format only carries segments of a first format from the same source (i.e., segments that were *received* from the same source). However, in addition to the fact that *Caves* fails to disclose an outgoing payload section constructed by linking successively generated aggregate data segments, as discussed above with respect to amended Claim 1, *Caves* also fails to disclose that outgoing payload sections are constructed for a telephony device from which incoming media packets were *not received*, as recited by Claim 3, and similarly, although not identically, by Claim 36. Furthermore, the Examiner does not indicate any portions of *Caves*, *Turner*, or *Robinett* that disclose, teach, or suggest this limitation.

For at least this additional reason, Claims 3 and 36 are allowable over the cited references. Therefore, Applicants respectfully request reconsideration and allowance of Claims 3 and 36.

As discussed above, a *prima facie* case of obviousness cannot be maintained for Claims 4-6 and 37-39 because *Robinett* actually teaches away from inserting silence placeholders into data packets, as recited in Claim 4, and similarly, although not identically, in Claim 37. Even assuming for the sake of argument that Claims 4 and 37 are obvious in view of a *Cave-Turner-Robinett* combination, Claims 5, 6, 38, and 39 are allowable because they recite additional limitations not disclosed by the cited references. Claim 5 recites "dividing a silence placeholder into one or more silence segments." Claim 38 recites similar, although not identical, limitations. Furthermore, Claim 6 recites "aligning a silence segment from a telephony device with a data segment or a silence segment of one or more of the other telephony devices." Claim 39 recites similar, although not identical, limitations. The cited references do not disclose, teach, or suggest these limitations, nor has the Examiner indicated any portions of the cited references which disclose, teach, or suggest the limitations of Claims 5-6 and 38-39.

For at least this additional reason, Claims 5-6 and 38-39 are allowable over the cited references. Therefore, Applicants respectfully request reconsideration and allowance of Claims 5-6 and 38-39.

Claim 10, as amended, recites "dividing a first payload section of a first incoming packet into one or more full segments of equal size and a remainder segment containing the remainder of the first payload section." Claims 26, 32, and 43 recites similar, although not identical, limitations. Claims 11-12, 20-21, 27, 33, 44-45, and 53-54 also recite the use of "remainder segments." The Examiner states that *Caves* discloses this limitation. (Office Action mailed 2/2/04, Page 3, ¶1, citing *Caves*, Figures 2, 4 and Col. 4, Lines 13-31). However, as discussed above with respect to Claim 15, the cited references fail to disclose remainder segments. Furthermore, Claim 11 recites "dividing a second payload section of a second incoming packet received after the first incoming packet into a completion segment, one or more full segments of equal size, and a remainder segment." Claims 18, 26, 32, 44, 51, and 58 similar, although not identical, limitations. Claims 12, 19, 27, 33, 45, 52, and 59 also recite "completion segments." The cited references fail to disclose, teach, or suggest a completion segment, let alone "dividing a second payload section of a second incoming packet ... into a completion segment..." nor has the Examiner indicated any portions of the cited references which disclose, teach, or suggest this limitation.

For at least these additional reasons, Claims 10-12, 18-19, 20-21, 26-27, 32-33, 43-45, 51-54, and 58-59 are allowable over the cited references. Therefore, Applicants respectfully request reconsideration and allowance of Claims 10-12, 18-19, 20-21, 26-27, 32-33, 43-45, 51-54, and 58-59.

Claim 13, as amended, recites "constructing a first outgoing payload section for a telephony device by linking one or more full aggregate data segments and a portion of another aggregate data segment, leaving a remainder aggregate data segment." Claim 46 recites similar, although not identical, limitations. Claims 14 and 47, which depend from Claims 13 and 46, respectively, also recite the use of a remainder aggregate data segment. The Examiner states that *Caves* discloses these limitations. (Office Action mailed 2/2/04, Page 3, ¶1, citing *Caves*, Figures 2, 4 and Col. 4, Lines 13-31). However, as discussed above with respect to Claim 15, the cited references fail to disclose remainder segments, let alone a remainder *aggregate* data segment.

For at least this additional reason, Claims 13 and 46 are allowable over the cited references. Therefore, Applicants respectfully request reconsideration and allowance of Claims 13 and 46, as well as Claims 14 and 47, which depend from Claims 13 and 46, respectively.

Claim 23 recites "an input transcoder operable to convert data in the incoming payload sections into a common media format." Claims 29 and 56 recite similar, although not identical, limitations. With respect to these claims, the Examiner merely states that the *Caves-Turner* combination does not specifically disclose the use of G.711, but that using this standard would be a matter of choice based on specific needs. (Office Action mailed 2/2/04, Page 3, ¶ 4). As such, the Examiner has not addressed the limitations of Claim 23, 29, or 56, but rather only the limitations of Claims 34, 30, and 57, which depend from Claims 23, 29, and 56, respectively. However, *Caves* merely discloses that user data packets may contain "compressed voice information" and "routine voice (or voice and data) packets." (*Caves*, Col. 3; Lines 3-22). *Caves* is silent as to whether or not the voice/data information is in a dissimilar format (or, for that matter, if the data is in a common format) such that there is a need to *convert* data in the incoming payload sections to a *common media format*, as recited in Claim 23, and similarly, although not identically, in Claims 29, and 56. Furthermore, the

Examiner has not indicated any portions *Turner* or *Robinett*, which disclose, teach, or suggest this limitation.

For at least this additional reason, Claims 23, 29, and 56 are allowable over the cited references. Therefore, Applicants respectfully request reconsideration and allowance of Claims 23, 29, and 56, as well as Claims 24, 30, and 57, which depend from Claims 23, 29, and 56, respectively.
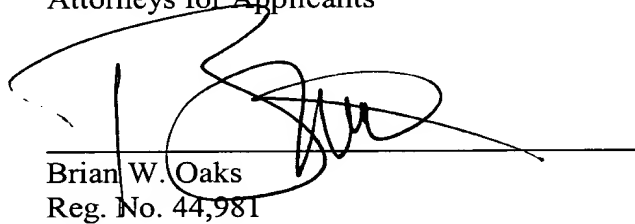
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CONCLUSION

Applicants have made an earnest attempt to place this case in condition for allowance. For the foregoing reasons, and for other reasons clearly apparent, Applicants respectfully request full allowance of all pending claims.

If the Examiner feels that a telephone conference would advance prosecution of this Application in any manner, the Examiner is invited to contact Brian W. Oaks, Attorney for Applicants, at the Examiner's convenience at (214) 953-6986.

Although Applicants believe that no fees are due, the Commissioner is hereby authorized to charge additional fees or credit any overpayments to Deposit Account No. 02-0384 of Baker & Botts, L.L.P.

Respectfully submitted,

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